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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/914,669	01/25/2002	Diane E. Goad	MC-158.USA	9994
5179	7590	12/15/2004	EXAMINER	
PEACOCK MYERS AND ADAMS P C			LUCAS, ZACHARIAH	
P O BOX 26927			ART UNIT	
ALBUQUERQUE, NM 871256927			PAPER NUMBER	

1648

DATE MAILED: 12/15/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action**

Application No.

09/914,669

Applicant(s)

GOADE ET AL.

Examiner

Zachariah Lucas

Art Unit

1648

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED \_\_\_\_\_ FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

**PERIOD FOR REPLY** [check either a) or b)]

- a) ☐ The period for reply expires \_\_\_\_\_ months from the mailing date of the final rejection.
- b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on \_\_\_\_\_. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
  - (b) ☐ they raise the issue of new matter (see Note below);
  - (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
  - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet.

3. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.
4. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: \_\_\_\_\_.

Claim(s) objected to: \_\_\_\_\_.

Claim(s) rejected: 1,4-13 and 15.

Claim(s) withdrawn from consideration: 2,3,14,16 and 17.

8. ☐ The drawing correction filed on \_\_\_\_\_ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_.
10. ☐ Other: \_\_\_\_\_

Continuation of 2. NOTE: Claims 1, 4, and 5 have been amended to read on methods "consisting essentially of" the indicated steps. The claims previously read on embodiments comprising the claimed methods, and thus permitted the use of steps in addition to those cited by the Applicant. The claims have not been fully examined for the patentability of claims excluding steps in addition to those identified in the claims. Thus, additional examination of the claims is required. Claim 5 has been additionally amended to include an additional requirement- comparison of the test mice with a control. This limitation has not been previously examined.

Continuation of 5. does NOT place the application in condition for allowance because:

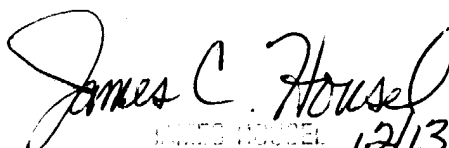
The amendments to the claims have not been entered. Arguments based on these amendments have therefore not been considered.

The Applicant restates their previous arguments in traversal of the obviousness rejection over Norval in view of Wright, Spruance, and Rooney. They argue that these references, and particularly the Norval and Spruance references, teach away from the claimed invention because they state a hypothesis that purportedly negates the combination of these references. However, as was stated in the prior action, the hypothesis of the Norval reference merely identifies a means to improve the practice of inducing HSV recrudescence in mice. The reference does not teach that the exposure of the mice to UV prior to infection is required, but only that "accounts for a high incidence of recrudescence lesion on subsequent stimulus." Thus, the hypothesis is merely a method of improving a previously known method. Such does not constitute a teaching away. See e.g., MPEP 2145 subsection X.D. 1(citing In re Gurley 31 USPQ2d 1130, 1132 (Fed. Cir. 1994) in support of this assertion). For these reasons, and the reasons of record, the rejection is maintained.

The Applicant argues that they have overcome the enablement rejection on the basis of the scope of a "statistically relevant sample." I.e. whether it includes "one" or "two or more" mice. It is noted that while the rejection in the prior action refers to embodiments with "one" mouse in the discussion, the rejection is directed to embodiments comprising either one mouse or two or more mice. Final Rejection, page 5. Because there is no argument or other evidence that two mice may make up a statistically relevant sample, particularly in the claimed inventions wherein the ability to achieve recrudescence is not uniform, the rejection is maintained.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Zachariah Lucas whose telephone number is 571-272-0905. The examiner can normally be reached on Monday-Friday, 8 am to 4:30 pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Housel can be reached on 571-272-0902. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Z. Lucas  
Patent Examiner

  
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12/13/04  
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